

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-13 are now present in this application. Claims 1, 7, 12 and 13 are independent.

Reconsideration of this application is respectfully requested.

Status of the Drawings

The outstanding Office Action contains no objection to the drawings, but the Office Action Summary, Form PTOL-326, does not indicate whether the amended drawings are accepted. Applicant assumes that because the previous objection to the drawings was not repeated it has been withdrawn, per M.P.E.P. § 707.07(e). However, Applicant respectfully requests clarification of the status of the drawings.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 2 and 8 stand rejected under 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed.

The Office Action states that the features of claims 2 and 8 do not exist in the disclosure as originally filed.

Applicant respectfully disagrees for the following reasons.

Claims 2 and 8 are supported by the originally filed disclosure. For example, the paragraph bridging pages 8 and 9 of the main body of Applicant's specification clearly states that if the optical disk 10 is determined to be a CD-RW or CD-R, the microcomputer 70 performs two operations in sequence, the first being an optimal tracking gain adjustment according to the determined type of the optical disk 10 and the second causing the tracking servo to be turned on (S31). That is, the tracking servo is previously turned off during the detection of the level of the wobble extraction signal, and then is turned on during the tracking servo adjustment operation (S31).

Accordingly, reconsideration and withdrawal of this rejection of claims 2 and 8 under 35 U.S.C. § 112, first paragraph, are respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 7, 12 and 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication 2004/0218497 to Choi et al. ("Choi"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d

1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

If the PTO fails to meet this burden, then the Applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the Applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

Moreover, as stated in M.P.E.P. § 707.07(d), where a claim is refused for any reason relating to the merits thereof, it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). *Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art

would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference. *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Claims 1 and 7 recite a combination of features that is not disclosed by Choi. For example, claim 1 recites detecting a level of a wobble extraction signal while a focusing servo is turned on but before a focusing servo adjustment has been completed. Claim 7 includes similar features, but is a means-plus-function claim. Claims 12 and 13 recite a combination of features that is not disclosed by Choi, including determining (or means for determining) the type of the loaded optical disk based on the detected wobble extraction signal level; and performing (or means for performing) a tracking servo adjustment operation according to the finally determined type of the loaded optical disk.

Choi does not disclose these claimed combinations of features. Choi clearly discloses, in paragraph [0011], that it does just the opposite, i.e., it discriminates between a plurality of types of disks using an amplitude of a wobble signal detected *during the controlling of the focus*. Choi also discloses, in Fig. 4, that it controls the optical disc in an on-focus state, in step 402, before it measures the amplitude of the wobble signal to determine the type of the disc.

In response to these arguments, the outstanding Office Action asserts that the feature of "detecting a wobble extraction signal while a focusing servo is turned on but before a focusing servo adjustment has been complete" is disclosed in Fig. 4, step 404 and in paragraph [0035].

Applicant respectfully disagrees with this conclusion, because paragraph [0035] explicitly states that "[I]n operation 402, the pickup unit 203 controls the optical disc 201 in a

focus-on state to adjust a focus on the recording surface of the optical 201 . . .” Thus, Choi clearly completes its focus adjustment before proceeding to the higher numbered steps, e.g. step 407, in which Choi determines the type of disc in the device.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of the claimed invention by Choi.

Rejections under 35 U.S.C. § 103

Claims 1, 7, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2004/0130991 to Tawaragi. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under Section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims

must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA

1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicant to come forward to rebut such a case.

Claims 1, 7, 12 and 13 recite a combination of features that is not disclosed by Tawaragi. Claim 1 recites detecting a level of a wobble extraction signal while a focusing servo is turned on but before a focusing servo adjustment has been completed. Claim 7 includes similar features in a varying scope. Tarawagi does not disclose this feature. Tarawagi clearly discloses, in

paragraphs [0029 and [0032], that it does just the opposite, because its wobble detection is of a focus error control signal, i.e., it uses an amplitude of a wobble signal detected during the controlling of the focus.

Claims 12 and 13 recite a combination of features that is not disclosed by Tawaragi. Claims 12 and 13 recite detecting a level of a wobble extraction signal while the focusing servo is activated and a tracking servo is turned off. Tawaragi does not disclose this feature. The Office Action states that this feature is disclosed in paragraph [0078] of Tawaragi. However, in paragraph [0078], Tawaragi clearly discloses that its optical disc drive determines a type of an optical disc DK in the reproducing state wherein the tracking servo is open, i.e., on. This situation is distinguished from the situation where the tracking control is closed, i.e., off, as explained in para. [0080], which Tawaragi indicates is not desirable, because the PU 101 may be broken. Tawaragi further states, in para. [0080], that according to its invention, it is possible to determine the type of an optical disk PK without closing the tracking servo control.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 1, 7, 12 and 13.

Reconsideration and withdrawal of this rejection of claims 1, 7, 10 and 13 are respectfully requested.

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,859,425 to Maegawa. This rejection is respectfully traversed.

Applicant respectfully submits that Maegawa does not even disclose discrimination between different types of optical disks based on detecting a wobble signal. Maegawa does not

explicitly disclose doing so and, although Maegawa discloses that its invention can be used for plural types of recording media, Maegawa's invention is directed to detect a wobble signal having high accuracy and stability when used to record information onto optical disks

Applicant cannot find any disclosure in Maegawa concerning how it goes about determining the type of disk that uses the wobble signals to improve recording of information onto an optical disk. The outstanding Office Action refers to col. 32, lines 5-44. However, that portion of Maegawa merely indicates that Maegawa's wobble detection circuit may be applied to a plurality of types of optical recording media.

Unfortunately, that is not the claimed invention. The invention recited in claims 1 and 7, for example, is directed to a method (or a system) for determining the type of an optical disk loaded into an optical disk device, comprising detecting a level of a wobble extraction signal while a focusing servo is turned on but before a focusing servo adjustment has been completed; determining (or means for determining) a type of a loaded optical disk based on the detected signal level; and performing (or means for performing) a tracking servo adjustment operation according to the determined optical disk type. Maegawa is only directed to wobble detection, per se, which is significantly different than what is recited in any of the pending claims.

Nor does the Office Action provide objective factual evidence of any inherent disclosure of the claimed invention by Maegawa. It should be remembered, as pointed out in the case law cited above, that for something to be inherently disclosed, it cannot be just possibly disclosed, and cannot just be probably disclosed. It must necessarily be disclosed. However, Maegawa fails to contain such disclosure of Applicant's claimed invention.

Moreover, Maegawa's wobble detection circuit 30 detects the wobble signal based on signal Sc and signal Sd (col. 12, lines 47-48), and those signals are generated using the tracking error signal and the focus error signal, as disclosed in col. 12, lines 35-63. Thus Maegawa teaches away from disclosing or suggesting the claimed invention.

Applicant notes that the immediately preceding argument has not been addressed in the outstanding Office Action, as required by M.P.E.P. § 707.07(f).

With respect to claim 3, what is recited is not use of a higher wobble signal level, although this is what is addressed in the rejection of claim 3. What is claimed is where the detected level of the wobble extraction signal for a disk for recording is higher than that of a disk for reproducing. Maegawa has no disclosure of this feature because it is directed only to disks that are recordable.

Applicant also notes that the immediately preceding argument has not been addressed in the outstanding Office Action, as required by M.P.E.P. § 707.07(f).

Accordingly, with respect to this rejection, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 1-13.

Reconsideration and withdrawal of this rejection of claims 1-13 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently

outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

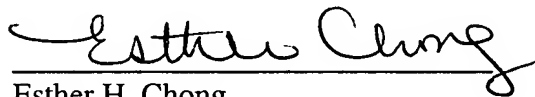
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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